REMARKS

This Response is submitted in response to the February 5, 2004 Office Action (Paper No. 16). Claims 1 through 25 are currently pending. Claims 1, 13, 15 and 18 are amended. Claims 9-12 and 16 are cancelled. New claims 26-29 are added.

Paragraphs 2 and 3 of the Office Action

Claims 18-23 have been rejected under 35. U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 18 and 23 have been amended in a manner believed to resolve the indefiniteness issues raised by the Examiner. Withdrawal of this rejection is respectfully requested.

Paragraphs 4-9 of the Office Action

Claims 1-10 and 13-14 have been rejected under 35. U.S.C. 102(e) as being anticipated by Stern (U.S. Patent No. 6,533,404). Claims 11-12, 15-21, and 24-25 have been rejected under 35. U.S.C. 103(a) as being unpatentable over Stern and Hilpert, Jr. (U.S. Patent No. 6,469,712). Claims 22-23 have been rejected under 35. U.S.C. 103(a) as being unpatentable over Stern, Hilpert, Jr. and Sparks et al. (U.S. Patent No. 6,167,382). These rejections are respectfully traversed.

Independent claim 1 has been amended to further recite that the playing of the preview clip be terminated upon moving said cursor out of said trigger field and across said boundary of said trigger field. Independent claim 15 has been amended to require that that the GUI be adapted to instantly terminate playing of a preview clip when said cursor leaves its associated trigger field.

None of the prior art references disclose either of these limitations (let alone in combination with the other limitations of amended claim 1 or amended claim 15). While the Examiner asserts that the Hilpert, Jr. reference inherently teaches that a sound is terminated when a cursor leave a given position, this position is erroneous.

The Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex parte Levy, 17 USPQ 2d 1461, 1464 (B.P.A.I. 1990). Before a reference can be found to disclose a feature by virtue of its inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is necessarily present in the reference. Continental Can, 948 F.2d at 1268-69, 20 USPQ 2d at 1749-50. The test of inherency is not satisfied by what a reference "may" teach. Id., 20 USPQ 2d at 1749-50

The Hilpert, Jr. reference only indicates that a sound may be generated whenever the cursor or arrow is over a "menu item" or a "link" such as an active graphics area " (see col. 9, lines 47-60). However, the Hilpert, Jr. reference provides no teaching, description of suggestion whatsoever for terminating the sound when a cursor is moved out of away from a menu item or link let alone when a cursor is moved out of a trigger field and across a boundary of the trigger field as recited in the amended claim 1 or when the cursor leaves a trigger field as recited in the amended claim 15.

In fact, the embodiments disclosed in the Hilpert, Jr. reference teach *away* from such a feature. For example, in order to provide aural position feedback to indicate a relative position of an "object" from an "origin" or point of reference, a generated sound associated with the object fades in intensity as the screen is moved away from the origin and object (see col. 7, lines 1-56). Thus as the cursor is moved away from the object, the associated sound does not end but rather fades to inform a listener that the object is now further away. To terminate the sound as soon as the cursor leaves the object would eviscerate the purposes expressed under the Hilpert, Jr. reference because a listener would not be able to use the sound to determine its location from a point of reference. Thus, a person of ordinary skill in the art would not be led to the conclusion that the Hilpert, Jr. reference could be utilized in combination with the Stern reference in order to render claims 1 and 15, as they are amended, obvious. Therefore, the Examiner's conclusion of obviousness based on a finding of inherency is erroneous.

Accordingly, claims 1 and 15, as they are amended, are believed to be allowable over the cited prior art references. Claims 2-8, and 13-14 depend from the amended claim 1 and claims 17-25

depend from the amended claim 15. At least by virtue of their respective dependencies, claims 2-8, 13-14 and 17-25 are believed to be in condition for allowance. Withdrawal of the rejections under 35 U.S.C. §§ 102 and 103 is respectfully requested.

If for any reason an insufficient fee has been paid, the Examiner is hereby authorized to charge the insufficiency to Deposit Account No. 05-0150.

If the Examiner has any questions or needs any additional information, the Examiner is invited to telephone the undersigned attorney at (650) 843-3215.

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Respectfully submitted,

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